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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/120,105 09/10/93 WINTER

A HOE92F294

EXAMINER

IM52/0906

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WILSON, D
ART UNIT PAPER NUMBER

Handwritten number: 32

1713
DATE MAILED:

09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/120,105

Applicant(s)

WINTER ET AL.

Examiner

D. R. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,17-19,21-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,17-19,21-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Status of Application

1. The request filed on 7/25/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/120,105 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. Applicant's amendment filed 7/25/01 (previously filed on 6/11/01 and not entered), has been entered and fully considered with the following results.
3. The objection under 35 U.S.C. 132 to new matter and the corresponding rejection of Claim 30 under 35 U.S.C. § 112, first paragraph, are not overcome by applicant's argument and the rejection is maintained as is discussed below.
4. The amendment is not deemed to be persuasive in overcoming the rejection of Claims 15, 17-19, 21-25 and 27-31 under 35 U.S.C. 112, first paragraph, concerning the DSC characterization of the melting behavior of components of the blend, as well as that of the blend itself, and the rejection is maintained as is discussed below.
5. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, concerning, (i) the polymerized ethylene content, and (ii) the optionally substituted fluorenyl group, and in this regard the rejection is withdrawn. However, the rejection on the other bases are maintained as is discussed below.
6. The argument traversing the obviousness double patenting rejection is not deemed to be persuasive and is maintained as is discussed below.
7. The amendment overcomes the objection to the title and abstract. It is to be noted that no one could determine that the temperatures on page 13, lines 31-32, are a polymerization temperature range as opposed to a melting range, as has been explained by applicant. The Examiner accepts that Comparative Example 2 provides data for the blend. However, it remains that Comparison Example 1 has little meaning as no data is presented for the resulting blend.

Previously Cited Statutes.

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8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objection to New Matter

9. ***The amendments filed 12/26/00 and 7/25/01 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure.*** 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The basis of the objection to the amendment filed on 12/26/00 was stated in Detailed Action §10 of the Office Action of 3/6/01. The added material which is not supported by the original disclosure is as follows:

The scope of what is being claimed in new Claim 30 is not supported by Examples 1 and 23 as alleged by applicant as these Examples only concern polypropylene and a propylene/ethylene copolymer, i.e., they only support the scope of Claim 31.

Applicant's argument traversing the rejection is not deemed to be persuasive as it remains that the support by Examples 1 and 23 only concern polypropylene and a propylene/ethylene copolymer, whereas the claim includes other copolymers with propylene.

10. The added material of the amendment of 7/25/01, which is not supported by the original disclosure is as follows:

There appears to be no basis in the specification as filed for the amendment to Claim 17 reciting "a melting peak", i.e., one melting peak. In fact the specification teaches that "[t]he molding composition has a broad, bimodal or multimodal melting range in the DSC spectrum" (specification, page 2, lines 17-18, underlining added).

11. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

12. ***Claim 15, 17-19, 21-25 and 27-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.*** The subject matter in question is that discussed above concerning the amendments of both 12/26/00 and 3/6/01.

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13. **Claims 15, 17-19, 21-25 and 27-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.** Applicant depends on DSC characterization of the melting behavior of components of the blend, as well as that of the blend itself, in regards to both melting peak and width of the melting point endotherm. The crystallinity of both the components and the blend would be expected to be a function of the thermal history of the materials, yet the specification provides no data on thermal conditioning of the samples prior to measurement. (See for example the discussion in EP'189 regarding thermal fusion data as a function of thermal history). The basis of this rejection was stated in Detailed Action § 5(b) of the Office Action of 4/3/00 and has been further discussed in Detailed Action § 13 of the Office Action of 3/6/01. Applicant traverses the rejection not fully responding to the Examiner's arguments and relying on previous arguments which are not deemed to be persuasive for reasons of record.

35 U.S.C. § 112, Second Paragraph, Rejection

14. **Claims 15, 17-19, 21-25 and 27-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Bases of these rejections were stated in Detailed Actions § 6(a)(iii), 6(a)(iv), 6(c) and 6(d) of the Office Action of 4/3/00 and in Detailed Action § 15(a), 15(b), 15(d) and 17 of the Office Action of 3/6/01.

15. The language of Claim 17 is indefinite because:

- a. A bimodal or multimodal melting range would have more than one melting peak and it is indefinite as to which peak "the melting peak" refers. If there must be melting points differing by at least 5°C, then the claimed melting range must be at least bimodal. Applicant's allegation that the Examiner is misreading Claim 17 is interesting but is not deemed to be persuasive. The claim is to a composition made in the presence of two catalysts and applicant argues that somehow one is supposed to know that the melting points referred to are those obtained when the catalysts are used separately, and has earlier argued that is the melting points of fractionated polymers.

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However, in either event, this is not the language of the claims and a clear basis for this does not appear to exist in the specification. The amendment to the claim referring to "a melting peak" is further indefinite, because the specification teaches a bimodal or multimodal spectrum, and the claim refers to a difference in melting points of the components.

b. In the olefin of formula $R^aCH=CHR^b$, R^a or R^b cannot be an alkyl of 1 carbon atom when the other R^a or R^b is hydrogen, i.e., it cannot be propylene. Further, the definition of R^a or R^b when connected to make a ring is not specified, nor could they form a ring if they are hydrogen. Applicant traverses the rejection pointing to the description at page 12, lines 18-30. This is not deemed to be persuasive because it supplies no more information than in the claim.

16. The definition of R^3 and R^4 "--- where the substituents ---- form together with the atoms connecting them a ring" is indefinite, because it can't be told which atoms are connected together. Applicant traverses the rejection arguing that the claim "—is recognized language to one of ordinary skill in the art". This is not deemed to be persuasive because it merely states a conclusion without addressing the merits of the rejection.

17. Claim 24 is indefinite because it is not known what the definitions are of R^{11} and R^{12} , when they are connected to form a ring. As above applicant argues that the claim "—is recognized language to one of ordinary skill in the art", which is not deemed to be persuasive for the same reason given above.

Obviousness Double Patenting

18. ***Claims 15, 17-19, 21-25 and 27-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No.***

5,700,886 (Winter'886). The basis of this rejection was stated in Detailed Action § 11 of the Office Action of 4/23/00 and has been further discussed in Detailed Action § 18 of the Office Action of 3/6/01. The argument traversing the rejection is not deemed to be persuasive because the merits of the stated rejection have not been addressed. The issue is not whether the two inventions are different. The basis of the rejection is that the instant claims have overlapping subject matter and/or would have been obvious over what is claimed in the issued patent.

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Art of Interest/Technological Background

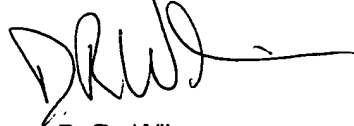
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seelert, not available as prior art, is cited as being of interest, as it appears to teach compositions which read on the instant invention.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. Wilson
Primary Examiner
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